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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,318	06/14/2002	Francesco Rossi	214771US0PCT	2414

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/09/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,318

Applicant(s)

ROSSI ET AL.

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 4-10 and 14-21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 4-10 and 14-21 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-10 and 14-21 have not been further treated on the merits.

Claims 1-3 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims include parenthetical numbers that are undefined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0333299.

The reference teaches a fibrous reinforcing material for bituminous mixes formed by chopping glass filaments having an average diameter of 13 microns into 13mm lengths. The instant specification teaches that the selected length and diameter of the desired fibers allow agglomeration of said fibers into flakes. As no specific method steps are recited to cause such agglomeration into flakes, flake formation appears to be intrinsic. Otherwise, the instant specification would be deficient in failing to teach one of ordinary skill in the art how to make the invention wherein the fibers are in the form of flakes. Therefore the reference cited anticipates claims 2.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP. 0333299, as applied above.

The difference between claim 12 and the instant claims is the utilization of waste glass as the source for the glass. It would have been obvious to one of ordinary skill in the art to use the least expensive source for a material. See, *In re Clinton*, 188 USPQ 365. The further difference between claims 3 and 13 is the use of E-glass (low alkali calcium alumina borosilicate). Page 5, lines 19-21 of the instant specification admit that E-glass is known to have a number of superior properties. It would have been obvious to one of ordinary skill in the art to employ e-glass because it is recognized in the art to have superior properties.

Having thus determined the scope and content of the prior art and the level of skill in the said art at the time the invention was made, it is the examiner's position that the claimed invention, as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. *In re DeBlauwe*, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean from the cited prior art. *Titanium Metals Corp. v. Banner*, 227 USPQ 773.

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Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different form and unobvious over that taught by the prior art relied upon. In re Brown, 173 USPQ 685, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

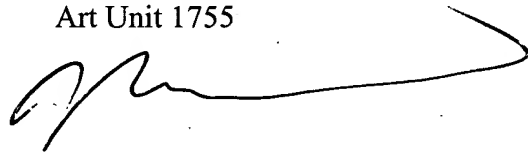
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 703-308-3454. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David M Brunsman
Primary Examiner
Art Unit 1755



DMB